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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,287	08/23/2001	William L. Honnef	53588-0510	4132
29989 7590 04/07/2008 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110				
EXAMINER				
LE, KHANH H				
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3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/914,287

Applicant(s)

HONNEF ET AL.

Examiner

KHANH H. LE

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) 14, 25 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-19, 23, 24, 26-28, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on January 09, 2008, after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2007 has been entered.

Claims 1, 23, 24, 26-28, 30, and 31 are currently amended.

Claims 1-19 and 23-31 are pending of which claims 14, 25 and 29 were previously withdrawn. Hence claims 1-13, 15-19, 23, 24, 26-28, 30 and 31 are herein examined.

Claims 1, 23, 24, 26, 27, 28-31 are independent.

Response to Arguments

2. Applicant's arguments have been considered but are substantially moot in view of the new ground(s) of rejection which follow.

At page 19, in discussing the Official Notice applied to claims 15-17, Applicant argue "*The Official Notice does not address all features of Claims 4-6 and 15-19 and therefore the Official Action fails to make a prima facie case of unpatentability based on the official notice.*" However, claims 4, 6, 18, and 19 are discussed separately from claims 15-17 (see Final rejection mailed 9/20/07, pages 6-8) thus the argument is unpersuasive as misapplied. The Official Notice statement argued applies only to claims 15-17.

At page 20, Applicant also challenges the Official Notices and demand support. In particular, surprisingly, Applicant challenges that it is old and well-known to apply taxes to purchase prices and that is customary to apply shipping and handling charges.

However Applicant's bald statements demanding support are not adequate and do not shift the burden to the examiner to provide evidence in support of Official Notice. Allowing such statement to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use the process of establishing a rejection of notoriously well known facts. *In re Boon*, 169 USPQ 231 (CCPA 1971).

The Applicant must rebut the Official Notice. Applicant did not do so. A mere request for documentation is not a rebuttal. This means that arguments must be presented as to why the Officially Noted Fact is not correct.

Since the challenge is defective, the Officially Noted Facts are taken as admitted. MPEP 2144.03.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

4. **Claims 1-3, 5, 7-11, 13, 23, 24, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al., US 6615189.**

Independent claims 1, 23, 24, and 26-28 and dependent claims 2, 8 and 10:

Phillips discloses:

A method of processing an electronic stored value certificate (abstract), comprising the computer-implemented steps of:

receiving and storing certificate information that identifies a recipient of the certificate, a recipient address (e.g. col. 4 lines 31-37), and an amount of the electronic stored value certificate (e.g. col. 3 lines 44-47);

issuing the electronic stored value certificate from a certificate issuer in response to successfully carrying out a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account associated with a merchant; and

creating and storing a unique identification value for the electronic stored value certificate in association with the certificate information as part of issuing the electronic stored value certificate;

storing an initial face value of the electronic stored value certificate,

determining a new face value by reducing the initial face value of the electronic stored value certificate by a portion of the initial face value in response to receiving information indicating redemption at the merchant of the portion of the initial face value for goods or services, and

storing the new face value of the electronic stored value certificate (e.g. abstract; Figure 1 and associated text; col. 3 line 41 to col. 4 line 45 explicitly and/or implicitly disclose all the above steps);

displaying the new face value of the electronic stored value certificate to the recipient; repeating the steps of determining [[and]] storing, and displaying the new face value in response to successively received redemption information until the new face value of the electronic stored value certificate is zero (e.g. col. 4 lines 46-57; col. 5 lines 1-5; col. 2 lines 57-59 and 65-67: stored value card is used till balance is zero and recipient being able to add value to the card via internet suggests the claimed steps of displaying, storing, and redisplaying the new face value, to apprise recipient of current value, after successive redemptions, and to enable adding more value);

wherein the unique identification value is a random value (a unique identification value is implicit to uniquely identify the stored value card or account, see col. 3 lines 58-60; such value is also interpreted as being a random value);

wherein the unique identification value is operable for redemption of the electronic stored value certificate at the merchant by communication of the merchant with the certificate issuer in a redemption transaction that does not traverse the commercial credit card network and wherein the unique identification value is non-negotiable in a commercial credit card network (e.g. col. 3 lines 58-67 and col. 3 lines 2-5 :even though the commercial credit card network may be an affiliate, it is only one possible embodiment in Philips ; a “third party processor” suggests a non-credit card entity) .

(**Note:** The instant specification discloses tracking the face value but not specifically to a zero balance. Though this may be implied, it is noted PHILLIPS discloses as much as the specification.)

Claim 3:

PHILLIPS discloses the method of claim 1 above and further discloses the gift-giver profile is taken from prior sales data (Figure 1 and associated text: e.g. item 100: solicitation of gift-giver; item 140: access her profile).

Claims 5, 9 and 11:

PHILLIPS discloses the method of claim 1 above and further discloses redemption against many sellers' products (col. 5 lines 36-43) and necessary relationships with sellers are established (col. 5 lines 36-43). Implicitly that means remitting by a computer (e.g. Fig. 2 item 332 or Figure 1 items 190, 200, 220) to sellers the value corresponding to their products that gift recipient selects. Which reads on “generating and returning an amount redeemed to a merchant “.

Claim 7:

The limitations of claim 7 are interpreted as a redemption process by gift recipient wherein recipient information including certificate current balance is updated. As discussed above, PHILLIPS discloses the method of claim 1 above and thus discloses all limitations of claim 7.

Claim 13:

PHILLIPS discloses the method of claim 1 above and further discloses a call center for redemption (e.g. Figure 2 item 240 and associated text).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips as applied to claim 1 above, and further in view of Walker et al., US 6138106.**

Claim 4:

Phillips discloses the method of claim 1 above. As discussed above, Phillips discloses displaying the new face value of the electronic stored value certificate to the recipient; repeating the steps of determining [[and]] storing, and displaying the new face value in response to successively received redemption information until the new face value of the electronic stored value certificate is zero (e.g. col. 4 lines 46-57; col. 5 lines 1-5; col. 2 lines 57-59 and 65-67: stored value card is used till balance is zero and recipient being able to add value to the card via internet suggests the claimed steps of displaying, storing, and redisplaying the new face value, to apprise recipient of current value, after successive redemptions, and to enable adding more value).

This means Phillips discloses “a statement” as claimed, because “a statement” is interpreted as the current value of the certificate.

Phillips discloses an email notification to recipient and recipient ability to view the certificate as discussed above but does not specifically disclose "a hyperlink that contains the unique identification value so the recipient may view the certificate". However, as discussed in previous Office Actions, Walker discloses such electronic mail notification message to the recipient of the electronic stored value certificate that includes a hyperlink that contains the unique identification value so the recipient may view the certificate within a browser (col. 7 lines 56-58; col. 5 lines 27-37). Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a "PHOSITA") to add such teaching of Walker to Phillips to facilitate viewing of the certificate and its status.

7. Claims 6, 12 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over PHILLIPS as applied to claim 1 above in view of legal precedents and/or Official Notice.

Claim 6:

PHILLIPS discloses the method of claim 1 above. PHILLIPS does not specifically disclose "applying the electronic stored value certificate to the order by reducing the current value of the electronic stored value certificate to zero) ; and attempting to receive the balance due for the order by carrying out a charge transaction that transfers value from an account associated with the recipient of the electronic stored value certificate to a certificate issuer with which the electronic stored value certificate may be redeemed; and restoring the electronic stored value certificate to its previously determined current value in response to failure of the charge transaction."

However, PHILLIPS discloses the card balance is depleted against purchases till it becomes zero (col.4 lines 48-54) and recipient can add value by other means including charge cards (col. 4 lines 54-56; col. 5 lines 1-8).

Thus, in case the stored value card balance is insufficient for a certain purchase, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a "PHOSITA"), from the PHILLIPS's teachings above, to "appl[y] the electronic stored

value certificate to the order by reducing the current value of the electronic stored value certificate to zero; and then attempt[i] to receive the balance due for the order by carrying out a charge transaction that transfers value from an account associated with the recipient of the electronic stored value certificate to a certificate issuer with which the electronic stored value certificate may be redeemed” in order to cover the insufficient funds” as claimed, (i.e. this would be an obvious alternative to allowing adding value to the stored value card, as taught by PHILLIPS) to allow completing the purchase.

Further, customarily if there are insufficient funds, the purchase would be void too. Thus in case the recipient attempts to add needed value by charge card and fails, it would have been obvious to a PHOSITA to void the purchase transaction and restore the electronic stored value certificate to its previously determined current value.

Claim 12:

PHILLIPS discloses the method of claim 1 above but does not specifically disclose selling its own a “merchant-branded” stored value certificate to gift giver. However it discloses stored value cards which are credit cards and which are co-branded with a sponsor (i.e. merchant) (col. 5 lines 64-65). Thus it would have been obvious to a PHOSITA to delete the credit card function if this function is not desired for any reason and arrive at the claimed invention because the deletion of the element with a corresponding loss of function has been held to be obvious, see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

Claims 15-17:

PHILLIPS discloses the method of claim 1 above.

However PHILLIPS does not disclose (Claim 15) a condition to redeem a minimum purchase amount ; (claim 16) recipient needs be first time customer ; (claim 17) a condition to buy specified goods and services.

However, Official Notice is taken that it is old and well-known for companies to provide employee rewards or for merchants to provide loyalty values in the form of reward certificates. It would have been obvious to one skilled in the art at the time the invention was made to use the PHILLIPS system as a vehicle to effect providing such loyalty or reward values. It is also well-

known to impose conditions, such as the claimed limitations above, usually for co-branding purposes or to promote sales of a sponsoring merchant. Thus it would have been obvious to a PHOSITA to impose the above claimed conditions to the PHILLIPS system to achieve the above co-branding, or sales promotions goals.

(Note: Phillips at col. 5 line 62 to col. 6 line 2, in another embodiment with stored card as credit card, is support for the Official Notice that a condition to buy specified goods and services (claim 17) is old and well-known).

Claims 18 and 19:

PHILLIPS discloses the method of claim 1 above.

However, PHILLIPS does not disclose taxes, shipping or handling charges added to the purchase total , and “determining whether applying the current value of the electronic stored value certificate to the amount of the order results in a balance due for the order, and if so, generating information that prompts the recipient to add value to the certificate.”

However, Official Notice is taken that taxes are often added to a purchase price and also it is customary to include shipping and handling charges. Thus when necessary, they obviously would have been added to a PHILLIPS 's purchase by a PHOSITA.

Further PHILLIPS discloses recipients adding value by charge card when the certificate value is not sufficient for the total purchase price (col. 9 lines 42-48 and 16-24).

Thus, it would have been obvious to a PHOSITA to add the above claimed limitation to PHILLIPS , in case adding taxes, shipping or handling charges would exceed the gift value to afford the total purchase.

8. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over PHILLIPS in view of legal precedents.

Independent claim 30:

The limitations which are common to the independent claims discussed above are disclosed by PHILLIPS as discussed above.

Further, Phillips's data service 200 dealing with many sellers is in effect a third party certificate issuer (e.g. Figure 1 items 190, 200, 220 or Fig. 2 item 332 and associated text; col. 5 lines 36-43).

In the alternative, claim 30 is method claim and having a third party issue the certificate does not affect the method in a manipulative sense. In other words the same steps are present i.e. issuing, activating, redeeming whether it is issuing and activating by the third party or not. Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) held: “[To] be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.” Here, the third party merely uses the issuing/activating structures, and that does not affect the overall method, thus per Ex parte Pfeiffer, the third party issuer limitation is not given patentable weight.

Independent claim 31:

The limitations common to independent claims discussed above are disclosed by PHILLIPS as discussed above.

PHILLIPS does not disclose a reseller of the gift certificate.

However, claim 31 is a method claim and having a reseller resell the certificate does not affect the method in a manipulative sense. In other words the same steps are present i.e. issuing, activating, redeeming whether it is issuing and activating by the reseller or not (i.e. no extra steps are claimed in view of the existence of a reseller). Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) held: “[To] be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.” Here, the reseller merely uses the issuing/activating structures, and that does not affect the overall method, thus per Ex parte Pfeiffer, the reseller limitation is not given patentable weight.

Further, even in structure claims, it has been held that making parts separable would be obvious “if it were considered desirable for any reason” . See In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (“The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is “press fitted” and

therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose."). Here the reason for adding a reseller to PHILLIPS might be that the reseller performs the task more efficiently or at better costs.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Freeman US 6450407 discloses displaying e-gift certificates or coupons.

Dorf US 6000608 discloses multi-function card.

Christensen discloses e-coupons/gift certificates.

Philips US 7174317 discloses debit or stored value cards to others.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH H. LE whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Khanh H. Le/

Examiner, Art Unit 3688

March 28, 2008

/Eric W. Stamber/

Supervisory Patent Examiner, Art Unit 3622